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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,850	03/23/2001	Roger de la Torre	514362000100	6920

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Cameron A. King
Morrison & Foerster LLP
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San Francisco, CA 94501

EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/17/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,850

Applicant(s)

TORRE ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 11-27 and 31-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 10 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 4-8, 11-27 and 31-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8, 10, 14. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 31-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.
2. Applicant's election with traverse of Group I in Paper No. 13 is acknowledged. The traversal is on the ground(s) that the examiner failed to provide an example of how the product could be deployed using different methods. This is not found persuasive because the apparatus requires creating a hole in the patient's stomach, a guidewire, a grasping tool, removing the grasping tool through the esophagus, etc. all of which are not required for the apparatus. Thus, the device could be inserted entirely through the stomach, entirely through the esophagus, with the pull method, etc.

The requirement is still deemed proper and is therefore made FINAL.

3. Applicant's election of Species I (Figures 1-6) in Paper No. 13 is acknowledged. Summary: Claims 1-3, 9-10, and 28-30 are under consideration. Claims 4-8, 11-27 and 31-45 are withdrawn from consideration.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: elements 99 and 110. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kantrowitz et al. in US Patent No. 4,051,840.

Regarding claim 1, Kantrowitz et al. disclose a space-occupying device (element 10 with associated components) having an expandable member (10) and one or more fasteners (13, 14 and sutures) secured to the expandable member and **capable** of anchoring the device within the patient's stomach, where the one or more fasteners is configured such that portions thereof **can** extend at least partially through the patient's stomach wall but not external to the patient's body, as recited in column 2 and seen in figures 1-6. Given the structure of the device the device is clearly **capable** of anchoring the device within the patient's stomach, where the one or more fasteners is configured such that portions thereof **can** extend at least partially through the patient's stomach wall but not external to the patient's body.

Regarding claim 2, Kantrowitz et al. disclose that as applied to claim 1, as well as, an expandable member (10) that is inflatable, as recited in column 2, lines 33-67.

Regarding claim 3, Kantrowitz et al. disclose that as applied to claim 1, as well as, fasteners that are sutures, as recited in claim 2, lines 57-65.

Regarding claim 9, Kantrowitz et al. disclose a space-occupying device (element 10 and associated components) for deployment having an expandable member (10) and means for anchoring (13, 14, and sutures) the device where the anchoring means are **capable** of extending at least partially through the patient's stomach wall but not external to the patient's body, as recited in column 2 and seen in figures 1-6. Clearly the device is **capable** of extending at least partially through the patient's stomach wall but not external to the patient's body. Further, the phrase, "means for anchoring the device within the patient's stomach" is a statement of intended use and not given patentable weight.

Regarding claim 10, Kantrowitz et al. disclose that as applied to claim 9, as well as an expandable member (10) that is inflatable, as recited in column 2, lines 33-67.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berson in US Patent No. 4,246,893 in view of Kantrowitz et al. in US Patent No. 4,051,840.

Regarding claim 28, Berson discloses method of introducing a space-occupying device (element 2 with associated components) within the stomach of a patient via introducing the space-occupying device (element 2 with associated components) into the patient's stomach where the space-occupying device includes an expandable member (2).

However, Berson does not disclose a method of anchoring the device where the device has one or more fasteners attached thereto; and fastening the device to the patient's stomach wall such that portion of the fasteners extend at least partially through the patient's stomach wall but do not extend externally of the patient's body. On the other hand, Kantrowitz et al. teach a method of fastening where an item is sutured to the desired location. Thus, it would be obvious to one with ordinary skill in the art to modify the invention of Berson to anchor the device within the patient's stomach for the purpose of limiting movement of the device for proper function and decreasing the risk of device damage or leakage.

Regarding claim 29, Berson as modified by Kantrowitz et al. disclose that as applied to claim 28. Further Kantrowitz et al. also teach fasteners that are one

or more sutures, as recited in column 2. Thus it would be further obvious to use the well-know attachment sutures for the purpose of safe attachment.

Regarding claim 30, Berson as modified by Kantrowitz et al. disclose that as applied to claim 28 and it is clearly within the scope of this modification inflate the device after fastening the device to the patient's stomach wall.

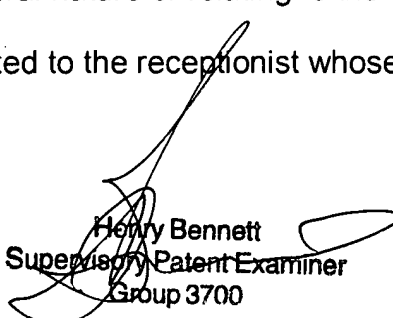
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,535,764; US Patent No. 6,432,040; US Patent No 6,293,923; and US Patent No. 6,102,922.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Henry Bennett
Supervisory Patent Examiner
Group 3700

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